

Serial No: 09/659,653

Attorney Docket No.: 1999-0541

REMARKS

Claims 1-6, 9, 15 and 16 stand rejected under 35 USC 103(a) as being unpatentable over Blakeslee in view of Montlick. In addition, claims 7, 8, 13, 17 and 18 stand rejected under 35 USC 103(a) as being unpatentable over Blakeslee and Montlick in view of Cobbley.

These rejections are respectfully traversed.

Applicants' independent claims 1 and 15 both recite that after a typewritten message is displayed on a mobile device, and a handwritten message is input to that device, the handwritten and typewritten messages are transmitted together in the same message field to another communication device. See, e.g., claim 1, lines 8-10 and claim 15, lines 7-9. The rejection of these claims relies on a finding that the Montlick system meets this limitation. See, for example, p. 3, lines 3-4 of the Office action.

It is respectfully submitted, however, that that Montlick does not, in fact, meet this limitation.

Applicants will assume for purposes of argument that the various pieces of text displayed in the Montlick system—including, for example, text 70 (FIG. 3) pointed to in the Office action—can be said to be a “typewritten message” such as recited in applicants' claims. Moreover, the user in Montlick does input handwriting, e.g., handwriting 71, on the display that is displaying the typewritten information. When the user is done, however, only the handwritten information gets transmitted back to Montlick's central computer. This is in direct contradistinction to the language of applicants' claims requiring that both the handwritten information and the typewritten information are transmitted together.

In particular, after the user in Montlick has generated the handwritten information, that information is transmitted to Montlick's central computer (col. 7, lines 63-67), where it is stored in the form of an electronic ink file (col. 8, lines 33-35). However, any typewritten material that had been displayed at the time that the user had made his/her handwritten entries is not transmitted along with it back to the central computer. Indeed, there is no need to do this for that since the central computer still has all the information. Rather, what happens is that the electronic ink file is digitally associated with a reference code associated with a particular form and

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a particular patient (col. 8, lines 35-40). When it is desired to see the handwritten and typewritten material, the central computer sends those two diverse elements down to the user, where they are re-combined to recreate the total image by having the electronic ink file overlaid on top of the typewritten information (col. 8, lines 48-54).

Indeed, Montlick expressly points out that because of this overlay function, the computer system only stores one copy of each form (typewritten information). It is thus clear that when the user causes his/her handwritten information to be sent, the typewritten information does not go with it. In this regard, reference may be made, for example, to col. 8, lines 58-64 wherein Montlick states

It will further be appreciated that only one digital copy of each form (for example page 50) need be stored in the memory of the central computer system and that the records of a patient will include a plurality of digital documents which include electronic ink and reference to a particular form upon which the electronic ink is to be overlaid [Emphasis added].

See also, for example, col. 9, lines 56-58 and col. 10, lines 18-23.

It is thus respectfully submitted that a key element of applicants' claimed invention that was asserted in the Office action to have been taught by Montlick—and thereby assertedly rendering applicants' invention obvious—is not, in fact, taught by Montlick after all.

Moreover, there would have been no motivation on the part of the person of ordinary skill to combine the Blakeslee and Montlick references. Blakeslee is concerned with e-mail types of communications between two humans. Montlick is concerned with data storage, retrieval and communications between a human and a computer. Thus it is not clear in what way, or why, a person skilled in the art would be motivated to incorporate teachings from Montlick into Blakeslee as the Office action suggests.

The Office action does suggest a motivation for combining the references, that reason being "in order to reduce loss in accuracy by not having to attempt to recreate any of the handwriting data into text." This statement of motivation appears to have been derived from Montlick itself based on statements at, for example, col. 2, lines 37-40 and col. 3, lines 46-47. However, this is simply a statement of the fact that the handwritten information that is input by the user in Montlick is retained in that form.

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This has nothing to do with the fact that typewritten information was displayed at the time that the handwriting was input.

In point of fact, Blakeslee already incorporates that notion. That is, Blakeslee transmits handwriting as handwriting rather than attempting to perform any kind of handwriting recognition and conversion to text. See, for example, 12C and 12D in FIG. 2. Thus the motivation for combining the references suggested in the Office action is not there because the reduction of the loss in accuracy by not having to attempt to recreate any of the handwriting data into text is already present in Blakeslee.

In summary, then, it is submitted that, first of all, Montlick does not in fact teach the claimed feature of transmitting the handwritten and typewritten information together from the device into which the handwriting was input to another device, as applicants' claims require. Moreover, it is submitted that there would be no motivation on the part of the person of ordinary skill to combine the teachings of these references. It is specifically submitted that, as explained above, the motivation to combine the references suggested in the Office action is not a valid one.

Inasmuch as all of the outstanding claim rejections rely on the asserted combination of Blakeslee with Montlick, it is believed that the foregoing establishes the patentability of all of the claims pending in the application. Accordingly, reconsideration and passage of the application to issue are earnestly solicited.

Respectfully submitted,

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